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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,205	01/16/2002	Masaya Hiramitsu	Q68085	2511
23373	7590	06/21/2004	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			WYROZEBSKI LEE, KATARZYNA I	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/046,205	Applicant(s) HIRAMITSU, MASAYA	
	Examiner Katarzyna Wyrozebski	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

In view of the applicant's amendment and reconsideration of the prior art of record, 2nd non-final office action is issued in view of new grounds of rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by WIDEMAN (US 6,057,392).

The prior art of WIDEMAN discloses rubber composition comprising silica, carbon black, rubber (col. 12, Table II) and tackifier resin in amount of 0.5-10 pbw (col. 8, lines 1-2).

The amount of styrene butadiene rubber and butadiene rubber is more than 40 pbw. SBR has bound styrene content of 23.4 (for that particular example) and butadiene rubber less than 60 wt %.

The accelerators in the composition of WIDEMAN are utilized in amount of 1.8 pbw (see examples) and one of the accelerators that can be utilized in thiuram (col. 8, line 47).

The composition of WIDEMANN can be utilized to make component of a tire tread (col. 9, line 54-55).

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In the light of the above disclosure the prior art of WIDEMAN anticipated requirements of claims rejected above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 3, 4, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIDEMAN (US 6,057,392) in view of SANDSTROM (US 5,901,766).

The discussion of the disclosure of the prior art of WIDEMAN from paragraph 2 of this office action is incorporated here by reference.

The difference between the present invention and the disclosure of the prior art of WIDEMAN is different recitation of the amounts of rubber, where this time BR alone is not less than 40 %, ratio of BR and SBR and fillers.

With respect to the above argument the prior art of SANDSTROM discloses composition also for tire tread comprising BR in amount of 50 wt % and SBR in amount of 50 wt %.

The ratios of silica filler to carbon black are encompassed by the prior art of SANDSTROM since the specification of this prior art discloses that the silica is utilized in amount of 15-80 wt % (col. 4, line 38) and carbon black is utilized in amount of 5-125 wt % (col. 5, line 20).

Composition comprising such amounts of rubber and filler are shown to be useful for making tire tread composition.

In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art to utilize the amounts of rubber and filler as disclosed in SANDSTROM in the composition of WIDEMAN and thereby arrive at the present invention. Such combination would still provide rubber composition for tire tread.

7. Claims 1-4, 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over SANDSTROM (US 6,221,953) '953 in view of SANDSTROM (US 5,901,766) '766.

The prior art of SANDSTROM'953 discloses composition for tire tread comprising combinations of three different resins in amount of at least 2 pbw of each. The total would therefore be at least 6 pbw (col. 2, lines 58-62).

The rubbers in compounding tire treads of SANDSTROM'953 include SBR, BR, IR and the like (col. 6, lines 10-16).

Fillers utilized in compounding tire tread composition include carbon black in amounts of 70-100 pbw (col. 7, lines 60-62) and silica (col. 7, line 47).

The difference between the present invention and the disclosure of the prior art of SANDSTROM'953 are the amounts of rubbers and fillers.

With respect to the above argument the prior art of SANDSTROM'766 discloses composition also for tire tread comprising BR in amount of 50 wt % and SBR in amount of 50 wt %.

The ratios of silica filler to carbon black are encompassed by the prior art of SANDSTROM'766 since the specification of this prior art discloses that the silica is utilized in amount of 15-80 wt % (col. 4, line 38) and carbon black is utilized in amount of 5-125 wt % (col. 5, line 20).

Composition comprising such amounts of rubber and filler are shown to be useful for making tire tread composition.

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In the light of the above disclosure, it would have been obvious to one having ordinary skill in the art to utilize the amounts of rubber and filler as disclosed in SANDSTROM'953 in the composition of SANDSTROM'766 and thereby arrive at the present invention. Such combination would still provide rubber composition for tire tread.

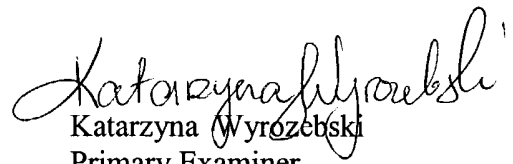
The applicants' arguments with respect to the rejections applied in the first office action on the merits are considered moot due to discontinuation of these rejections against present claims. The prior art of SANDSTROM'766 was discontinued as a 102 b rejection against present claims, since the amount of the rein is outside the range claimed in independent claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katarzyna Wyrozebski whose telephone number is (571) 272-1127. The examiner can normally be reached on Mon-Thurs 6:30 AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Katarzyna Wyrozebski
Primary Examiner
Art Unit 1714

June 17, 2004